

## REMARKS

This is a full and timely response to the outstanding final Office Action mailed December 9, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 102(b)**

Claims 1 and 5 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Yuasa, et al. (“Yuasa,” U.S. Pat. No. 5,878,198). Applicant respectfully traverses this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

As is noted above, Applicant’s claims 1, 5, and 8 have been amended through this Response. In view of those amendments, Applicant respectfully submits that the rejections are moot as having been directed to the claims in another form. Applicant notes, however, that Yuasa does not teach a method, system, or printing device with which a printing device merges received data with static form data *already stored on* the printing device such that printing a hard copy form is possible *without* the need to send the static form data to the printing device and such that a copy of the static form data need only be stored on the printing device. Instead, in each of Yuasa’s three disclosed embodiments, “form information” (i.e., the form) and “form data” (i.e., the text to populate the form) is

coordinated by a CPU 305 of Yuasa's system and then sent from the CPU to a page printer 311. For example, Yuasa states "a CPU 305 controls the entire system" (column 6, lines 20-23) and describes a form overlay controller program 506 controlled by the CPU that sends the form information (i.e., the form) and the form data (i.e., the text to populate the form) through a printer driver 507 to the page printer 311 (column 7, line 64 to column 8, line 4). Therefore, as the other prior systems described by Applicant in the Background of the Invention section of the specification, the user's computer must store a copy of the form in Yuasa's system. As is stated in the Background of the Invention section, a drawback of such systems is "the effort involved in acquiring, installing, and maintaining software on client machines." Applicant's specification, page 1, lines 18-20. Applicant's claimed methods, systems, and printing devices avoid that problem by enabling the form data to be stored in a single, central location, i.e., the printing device.

Due to the above, Applicant respectfully requests that the rejection of the claims be withdrawn.

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

### **A. Rejection of Claims 2, 4, and 6-10**

Claims 2, 4, and 6-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yuasa, LeClair, et al. ("LeClair," U.S. Pat. No. 6,636,891) and Pennell, et al. ("Pennell," U.S. Pat. No. 6,910,179). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or

generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

As is identified above, Yuasa does not teach several aspects of Applicant's claims independent claims 1, 5, and 8. In that LeClair and Pennell do not remedy the deficiencies of the Yuasa reference, Applicant respectfully submits that claims 2, 4, and 6-10, which depend from claims 1, 5, and 8, are allowable over the Yuasa/LeClair/Pennell combination for at least the same reasons that claims 1, 5, and 8 are allowable over Yuasa.

#### **B. Rejection of Claims 11-13, 15, 24, and 25**

Claims 11-13, 15, 24, and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Al-Hussein (U.S. Pa. No. 5,809,167) and Yuasa. Applicant respectfully traverses this rejection.

As is noted above, Applicant's claims 11, 19, and 24 have been amended through this Response. In view of those amendments, Applicant respectfully submits that the rejections are moot as having been directed to the claims in another form. Applicant reiterates for the Examiner's consideration, however, that Yuasa does not teach a method, system, or printing device with which a printing device merges received data with static form data already stored on the printing device such that printing a hard copy form is possible without the need to send the static form data to the printing device and such that a copy of the static form data need only be stored on the printing device. At least due to those distinctions, Applicant respectfully requests that the rejection of the claims be withdrawn.

**C. Rejection of Claims 14, 16-23, 26, and 27**

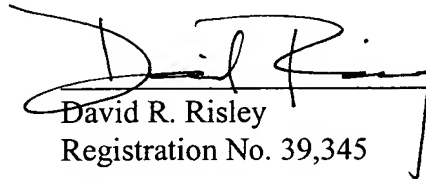
Claims 14, 16-23, 26, and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Al-Hussein (U.S. Pa. No. 5,809,167) and Yuasa, LeClair and Pennell. Applicant respectfully traverses this rejection.

As is identified above, Al-Hussein and Yuasa do not teach several aspects of Applicant's independent claims 11, 19, and 24. In that the LeClair and Pennell references do not remedy the deficiencies of the Al-Hussein and Yuasa references, Applicant respectfully submits that claims 14, 16-23, 26, and 27, which depend from claims 11, 19, and 24 are allowable over the Al-Hussein/Yuasa/LeClair/Pennell combination for at least the same reasons that claims 11, 19, and 24 are allowable over Al-Hussein/Yuasa.

**CONCLUSION**

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

2-9-06  
Mary McEwen  
Signature